

## **REMARKS**

### **I. Introduction**

With the cancellation of claim 12 herein without prejudice, claims 11, 13, 15 to 21 and 23 are pending in the present application. In view of the forgoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

The Office Action Summary does not include an acknowledgment of the claim for foreign priority and does not indicate whether a certified copy of the priority document has been received. A claim for priority to Application No. 102 45 343.8, filed in the Federal Republic of Germany on September 7, 2002, was made, *inter alia*, in the "Declaration and Power of Attorney" filed on September 9, 2005. At least the "Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US)," dated August 12, 2005 indicates that the priority document has been received by the United States Patent and Trademark Office. Applicants therefore again respectfully request acknowledgment of the claim for foreign priority and acknowledgment of receipt of the priority document with the next Office communication.

### **II. Rejections of Claims 11, 12, 13 and 21 Under 35 U.S.C. §§ 102 and 103**

Claims 11 and 21 were rejected under 35 U.S.C. § 102(b) as anticipated by Chen et al. (U.S. Patent No. 6,183,886). Claims 12 and 13 were rejected under 35 U.S.C. § 103(a) as unpatentable over Chen et al. It is respectfully submitted that these rejections should be withdrawn for at least the following reasons.

As an initial matter, the rejection regarding claim 12 has been rendered moot as claim 12 has been cancelled herein without prejudice.

While the Office Action admits that Chen et al. do not disclose a plug-in contact but contends that "[t]his feature is seen to be an inherent teaching of that device since a Fister [sic] disclose *the article (10) may be a strip to formed [sic] into an electrical connector . . . means the article 10 could be formed in any kind of connector including a plug-in connector*" (italics in original). To rely on the doctrine of inherency, "the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). Merely because a certain result or characteristic may occur or

be present in the prior art is insufficient to establish inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993). Indeed, inherency may not be established by probabilities or possibilities, and merely because a certain thing may result from a given set of circumstances is not sufficient. *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950 to 1951 (Fed. Cir. 1999). Thus, the present rejection must necessarily fail since the Office Action has not properly established inherency of the feature alleged to be inherent.

Notwithstanding the foregoing, amended claim 11 and claim 13 recite, *inter alia*, a structuring for a structured layer is such that particles having a size between 1 nm and 1  $\mu$ m are dispersed in a matrix. Claim 13 also recites, *inter alia*, that a proportion of the particles dispersed in the matrix is between 1 vol.% and 50 vol.%. The Office Action admits at page 5 that Chen et al. do not disclose these features (Applicants note that there appears to be a typographical error on page 5, paragraph 8 in which the Office Action appears to mistakenly reference Capp instead of Chen et al.). Regarding claim 13, however, the Office Action asserts that

[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the size of the particles in a range from 1 nano-meter and 1 micro-meter, and the between 1 vol.% and 50 vol.%, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Office Action, page 5. The Office Action's reliance on *In re Aller* is misplaced. Before the determination of optimal or workable ranges of a variable can be characterized as routine experimentation, a particular parameter must first be recognized as a result-effective variable, *i.e.*, a variable that achieves a recognized result. *In re Antonie*, 559 F.2d 618, 195 U.S.P.Q. 6 (C.C.P.A. 1977). The reference relied upon does not even suggest that a particle size and volume percentage claimed in claim 13 are such a results-effective variables, and the Office Action does not even assert that the particle size and volume percentage constitute results-effective variables. It is therefore respectfully submitted that claims 11 and 13 are allowable.

Claim 21 depends from claim 11 and therefore includes all of the features recited in claim 11. Accordingly it is respectfully submitted that Chen et al. do not render unpatentable this dependent claim for at least the same reasons more fully set forth above in support of the patentability of claim 11.

For at least the foregoing reasons, Applicants respectfully submit that the present rejections should be withdrawn.

### **III. Rejection of Claim 19 Under 35 U.S.C. § 102**

Claim 19 was rejected under 35 U.S.C. § 102(b) as anticipated by Fister et al. (U.S. Patent No. 5,916,695). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons.

Claim 19 recites, *inter alia*, a structured layer formed by a multilayer system which is made up of successive layers having different chemical compositions, the multilayer system including layers of indium and silver. Fister et al. describe a fourth layer 32 that

[m]ay then constitute a fourth constituent such as silver, silicon, aluminum, zinc, iron, chromium, manganese, cobalt, vanadium, indium or phosphorous.

Column 6, lines 43 to 46 (emphasis added). The word “or” clearly makes the list of constituents described in Fister et al. disjunctive. As such, nowhere do Fister et al. disclose at least the feature of a multilayer system including layers of indium and silver as recited in claim 19.

For at least the foregoing reason, Applicants respectfully submit that the present rejection should be withdrawn.

### **IV. Rejections of Claims 15, 18 and 20 Under 35 U.S.C. §§ 102 and 103**

Claim 20 was rejected under 35 U.S.C. § 102(b) as anticipated by Capp (U.S. Patent No. 5,316,507). Claims 15 and 18 were rejected under 35 U.S.C. § 103(a) as unpatentable over Capp. It is respectfully submitted that these rejections should be withdrawn for at least the following reasons.

Amended claims 15, 18 and 20 recite, *inter alia*, a structuring for a structured layer is such that particles having a size between 1 nm and 1 µm are dispersed in a matrix. The Office Action admits at pages 4 and 5 that Capp does not disclose this feature. Regarding claims 15 and 18, however, the Office Action asserts that

[i]t would have been obvious to one having ordinary skill in the art at the time the invention was to made to provide the size of the particles in a range from 1 nano-meter and 1 micro-meter , since it has been held that where the general conditions of a claim a are disclosed in the prior art, discovering the

optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Office Action, pages 4 and 5. The Office Action's reliance on *In re Aller* is misplaced. Before the determination of optimal or workable ranges of a variable can be characterized as routine experimentation, a particular parameter must first be recognized as a result-effective variable, *i.e.*, a variable that achieves a recognized result. *In re Antonie*, 559 F.2d 618, 195 U.S.P.Q. 6 (C.C.P.A. 1977). The reference relied upon does not even suggest that a particle size claimed in claim 13 is such a results-effective variable, and the Office Action does not even assert that the particle size constitutes a results-effective variable. It is therefore respectfully submitted that claims 15, 18 and 20 are allowable.

For at least the foregoing reasons, Applicants respectfully submit that the present rejections should be withdrawn.

**V. Allowable Subject Matter**

Applicants note with appreciation the indication of allowable subject matter included in claims 16, 17 and 23. In light of the amendments made to claims 11, 16, 20 and 23, it is respectfully submitted that claims 11, 13, 15 to 21 and 23 are in condition for immediate allowance.

**VI. Conclusion**

In light of the foregoing, Applicants respectfully submit that all pending claims are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

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